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In re Application of:  
TAYLOR, Stephen, Maxwell, et al. : DECISION ON REQUEST UNDER  
U.S. Application No.: 10/510,614 : 37 CFR 1.497(d)  
PCT No.: PCT/AU03/00415 :  
International Filing Date: 07 April 2003 :  
Priority Date: 08 April 2002 :  
Atty's Docket No.: 36677.30 (4050.003000) :  
For: USE OF C5A RECEPTOR :  
ANTAGONIST IN THE TREATMENT :  
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:

This decision is issued in response to applicants' "Response To Notification Of Missing Requirements And Petition Under 37 CFR 1.47(a)" filed 14 October 2005, treated herein as a request under 37 CFR 1.497(d) to correct the inventorship in the present application. Deposit Account No. 08-1394 will be charged the \$130 processing fee.

**BACKGROUND**

On 07 April 2003, applicant filed international application PCT/AU03/00415 which claimed a priority date of 08 April 2002 and which designated the United States. On 23 October 2003, a copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) by the International Bureau (IB). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 08 October 2004. The published international application identified a corporate applicant for all states other than the U.S., and three applicant/inventors for the U.S.: Stephen M. TAYLOR, Ian A. SHIELS, and Lindsay Charles BROWN.

On 07 October 2004, applicant filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 10 March 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) indicating that an oath or declaration acceptable under 37 CFR 1.497 was required.

On 14 October 2005, applicants filed the "Response To Notification Of Missing Requirements And Petition Under 37 CFR 1.47(a)" considered herein (with a request for the

required five-month extension of time). The response states that applicants have determined that there is a forth applicant/inventor for the present application, Michael WHITEHOUSE. The response includes a declaration that identifies four inventors (TAYLOR, SHIELS, BROWN & WHITEHOUSE). However, this declaration was executed only by the three inventors of record; the declaration has not been signed by Mr. WHITEHOUSE. The accompanying petition under 37 CFR 1.47(a) asserts that Mr. WHITEHOUSE has refused to execute the declaration.

### DISCUSSION

Where, as here, the filed declaration names additional inventors who were not identified on the international application, 37 CFR 1.497(d) requires applicant to submit: (1) a statement from each person being added as an inventor that any error in inventorship in the international application occurred without deceptive intent; (2) the processing fee; and (3) if an assignment has been executed by any of the original named inventors, the written consent of the consignee (in the form required by 37 CFR 3.73(b)). The present submission only satisfies item (2).

Regarding item (1), applicants have not submitted the required statement from the inventor being added, Michael WHITEHOUSE. Item (1) is therefore not satisfied.

Regarding item (3), applicant has not submitted the assent of the assignee to the change of inventorship. Item (3) is therefore not satisfied. It is noted that any such consent of the assignee must be accompanied by a proper statement under 37 CFR 3.73(b).

Based on the above, the present record does not satisfy all the requirements for correction of the inventorship under 37 CFR 1.497(d). Accordingly, the inventors of record remain Stephen M. TAYLOR, Ian A. SHIELS, and Lindsay Charles BROWN. Because the declaration filed with the present response identifies an additional inventor (Mr. WHITEHOUSE), the declaration is unacceptable under 37 CFR 1.497.

Applicants' petition under 37 CFR 1.47(a) seeking acceptance of the declaration without the signature of Michael WHITEHOUSE is moot, in that Mr. WHITEHOUSE is not currently an applicant of record herein.

Correction of inventorship is discussed in detail in MPEP § 201.03. In the analogous context of a petition under 37 CFR 1.48, the MPEP addresses situations such as the present case, where the required statements from the added or deleted inventors cannot be obtained, stating the following:

On very infrequent occasions, the requirements of 37 CFR 1.48(a) have been waived upon the filing of a request and fee under 37 CFR 1.183 (along with the request and fee under 37 CFR 1.48(a)) to permit the filing of a statement by less than all the parties required to submit a statement. *In re Cooper*, 230 USPQ 638, 639 (Dep. Assist. Comm'r Pat. 1986). However, such a waiver will not be considered unless the facts of record unequivocally support the correction sought. *In re Hardee*, 223 USPQ 1122, 1123 (Comm'r Pat. 1984). As 37 CFR 1.48(a) is intended as a simple procedural remedy and does not represent a substantive

determination as to inventorship, issues relating to the inventors' or alleged inventors' actual contributions to conception and reduction to practice are not appropriate for consideration in determining whether the record unequivocally supports the correction sought.

In those situations where an inventor to be added refuses to submit a statement supporting the addition or such party cannot be reached, waiver under 37 CFR 1.183 of the requirement for a statement from that party would be appropriate upon a showing of such refusal or inability to reach the inventor. Every existing assignee of the original named inventors must give its consent to the requested correction. Where there is more than one assignee giving its consent, the extent of that interest (percentage) should be shown. Where no assignment has been executed by the inventors, or if deletion of a refusing inventor is requested, waiver will not be granted absent unequivocal support for the correction sought. Petitions under 37 CFR 1.47 are not applicable to the requirement for statements from each originally named inventor.

An available remedy to obtain correction of inventorship where waiver of a required statement is not available to correct the inventorship in a particular application is to refile the application naming the correct inventive entity. A request under 37 CFR 1.48(a) would not then be required in the newly filed application as no correction would be needed. Furthermore, a request under 37 CFR 1.48(a) would also not be required in the prior application that was refiled, since the prior application will be abandoned. Benefit of the parent application's filing date would be available under 35 U.S.C. 120 provided there is at least one inventor overlap between the two applications. (Note: a sole-to-sole correction would not obtain benefit under 35 U.S.C. 120).

### CONCLUSION

Applicant's request to correct inventorship under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

The declaration filed 14 October 2005 is defective for failure to properly identify the inventors of record herein.

Deposit Account No. 08-1394 will be charged the \$130 processing fee for the request under 37 CFR 1.497(d).

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)" and must include the materials required to satisfy items (1) and (3) of a grantable request, as discussed above (i.e., the required statement from the added inventor and the consent of the assignee in the form required by 37 CFR 3.73(b)).

Failure to file a proper response will result in abandonment of the application.  
Extensions of time are available under 37 CFR 1.136(a)

The petition under 37 CFR 1.47(a) is **DISMISSED** as moot.

Please direct further correspondence with respect to this matter to Mail Stop PCT,  
Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria,  
Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT  
Legal Administration.

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